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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,818	03/06/2002	Yoshihiro Ozeki	SAEGI00.001APC	8140

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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/031,818

Applicant(s)

OZEKI ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on September 2, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 32-33, 36-44 is/are rejected.
- 7) ☒ Claim(s) 34 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 2, 2005 has been entered.

Claims 1-30 are cancelled.

Claims 33-44 are newly added.

Claims 33-44 are pending:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

### ***Claim Objections***

Claim(s) 40-41 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and/or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). In the interest of compact prosecution, claim(s) 40-41 are examined on the merits as being dependent on claim 36.

***Claim Rejections - 35 USC § 112***

Claims 32-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. Newly submitted claims 32 and 33 require a DNA sequence having a nucleotide sequence not less than 90% homologous with the nucleotide sequence shown in SEQ ID NO:1 which has four additional recited characteristics relating to size, terminal inverted repeat sequences, repetitions of sequences and duplication function. The combination of “a nucleotide sequence not less than 90% homologous with the nucleotide sequence shown in SEQ ID NO:1” and the four additional recited characteristics does not find support in the specification as originally filed and thus constitutes new matter. Newly submitted claim 33 also requires a DNA sequence having a nucleotide sequence not less than 90% homologous with the nucleotide sequence shown in SEQ ID NO:2 which has three additional recited characteristics relating to size, terminal inverted repeat sequences, and duplication function. The combination of “a nucleotide sequence not less than 90% homologous with the nucleotide sequence shown in SEQ ID NO:2” and the three additional recited characteristics does not find support in the specification as originally filed and thus constitutes new matter.

Claims 32-33 and 36-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record.

Applicants' arguments filed September 2, 2005 have been fully considered but they are not persuasive.

Applicants point out that this ground of rejection was not applied to claims 12 and 21 (now cancelled) which correspond to present claims 34 and 35. Applicants also point out that claim 31 is limited to SEQ ID NO: 1. Accordingly, Applicants maintain that claims 31, 34, and 35 meet the written description requirement. Regarding the remaining claims, while Applicants respectfully submit that the present claims meet the written description requirement, Applicants also make of record that they are presently conducting experiments, expected to be completed shortly, to show that the written description in the specification evidences possession of the invention at the time of filing. (reply page 6)

Applicants' assertions with respect to newly submitted claims 31, 34, and 35, which are not here rejected, are acknowledged. The remaining claims are rejected for reasons of record.

Claims 32-33 and 36-44 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated MITE-like element having the nucleotide sequence of SEQ ID NO:1, a transcriptional activation element having the nucleotide sequence of SEQ ID NO:3, and a transcriptional activation element having the nucleotide sequence of SEQ ID NO:14, and while being enabling for increasing transformation efficiency by transforming plant cells with a plasmid comprising a transgene expression cassette comprising an isolated MITE-like element having the nucleotide sequence of SEQ ID NO:1, a transcriptional

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activation element having the nucleotide sequence of SEQ ID NO:3, or a transcriptional activation element having the nucleotide sequence of SEQ ID NO:14 operatively joined to a promoter sequence, does not reasonably provide enablement for other isolated MITE-like elements, or for other transcriptional activation elements, or for isolated transcriptional activation elements that are capable of causing duplication of a target sequence, or for other types of methods. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims, for the reasons of record.

Applicant's arguments filed September 2, 2005 have been fully considered but they are not persuasive.

Applicants point out that present claim 31 is limited to an isolated miniature inverted-repeat transposable element consisting of a DNA having the sequence of SEQ ID NO: 1, and accordingly maintain that claim 31 clearly falls within the subject matter indicated as enabled by the previous Office Action. Applicants also point out that present claims 34 and 35 are limited to SEQ ID NOS: 3 and 14, respectively, and maintain that while these claims recite "an isolated transcriptional activation element" in the preamble, this is merely a recitation of intended use, such that claims 31, 34, and 35 are believed to meet the enablement requirement of 35 U.S.C. 112, first paragraph. Applicants additionally maintain that claims 43 and 44 are believed to be enabled, at least with regards to SEQ ID NOS: 1, 3, and 14, as the Examiner indicated in the previous Office Action that "Applicants have provided guidance with respect to how to use the disclosed MITE-like sequences to increase transformation efficiency and improve regeneration efficiency in plant cells". Regarding the remaining claims, while Applicants submit that all of the

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present claims are completely enabled, as noted above, Applicants are conducting experiments to further evidence that the specification as filed fully enables the present claims. These experiments are expected to be completed shortly. (reply pages 6-7)

Applicants' assertions with respect to newly submitted claims 31, 34, and 35, which are not here rejected, are acknowledged. Applicants' assertions with respect to the enablement of using the disclosed MITE-like sequences to increase transformation efficiency and improve regeneration efficiency in plant cells are also acknowledged, as set forth above in the rejection for scope of enablement. The remaining claims are rejected for reasons of record.

***Allowable Subject Matter***

Claim 31 is allowed.

Claims 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins  
Primary Examiner  
Art Unit 1638

CC

  
11/17/05